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EXAMINER

HUNTER, ALVIN A

ART UNIT PAPER NUMBER

3711

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,917

Applicant(s)

VESLIGAJ, ZELJKO

Examiner

Alvin A. Hunter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2004.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
4a) Of the above claim(s) 2 and 20 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,3-7,9-19,21-24 and 26-28 is/are rejected.
7) ☒ Claim(s) 8 and 25 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08/26/04.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention:

Species I: Claims 2 and 20 directed to a composite core having layers of metal and plastic;

Species II: Claims 3, 9-15, 21, and 25 directed to a composite core of plastic having metal particles.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 4-8, 16-19, 22-24, and 26-28 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with William Mason on June 17, 2005 a provisional election was made without traverse to prosecute the invention of Species 2, claims 3, 9-15, 21, and 25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the resilient insert as in claims 17 and 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

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number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Specification does not have antecedent basis for the width of the insert to be 50 to 80% as set forth in claim 17, only 50 to 100%.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 18 and 22 refer to a durometer hardness value. It is unclear what the hardness value is being that applicant has not set forth what durometer scale was used to measure the hardness.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 3, 5-7, 9, 11-14, 19, 21, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Okumoto et al. (USPN 5306450).

Regarding claim 1, Okumoto et al. discloses a composite core made of metal and plastic and an injection molded sheath enclosing the core (See Column 3, line 28, to Column 4, line 14).

Regarding claim 3, Okumoto et al. discloses the core having an injected molded plastic having metal particles dispersed therein.

Regarding claim 5, it would appear that the ratio claimed by the applicant would be inherent therein base on Figure 6.

Regarding claim 6, the metal in the core is steel or copper.

Regarding claim 7, the plastic in the core is nylon.

Regarding claim 9, see the above regarding claims 1 and 3.

Regarding claim 11, see the above regarding claim 6.

Regarding claim 12, see the above regarding claim 7.

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Regarding claim 13, Okumoto et al. discloses the sheath being made of a resilient plastic.

Regarding claim 14, the club head of Okumoto et al. is capable of being used as a putter head.

Regarding claim 19, the resilient insert is the sheath as inasmuch set forth by the applicant. See claim 1 regarding additional limitations.

Regarding claim 21, see the above regarding claims 3 and 5,

Regarding claim 22, Okumoto et al. inherently teaches the resilient section having a durometer value of 40 to 80 as much as set forth by the applicant being that the resilient section is made from nylon, a resilient plastic, as disclosed by the applicant.

2. Claims 16, 18, 24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Sebo et al. (USPN 3873094).

Regarding claim 16, Sebo discloses a main body having a front surface with an outer face, a lower edge and a non-resilient ball striking area **23** (which is the core) and a resilient section **16** having a face in a plane with the front surface outer face, a lower edge aligned with the front surface lower edge and an upper edge below the ball striking surface (See Figures 2-6 and Column 2, lines 28 through 56).

Regarding claim 18, Sebo inherently teaches the resilient section having a durometer value of 40 to 80 as much as set forth by the applicant being that the resilient section is made from polycarbonate, a resilient plastic, as disclosed by the applicant.

Regarding claim 24, see the above regarding claims 16 and 18.

Regarding claim 26, Sebo et al. discloses the non-resilient core made of steel.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 3-6, 9-11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Green (USPN 5324031) in view of Okumoto et al. (USPN 5306450).

Regarding claim 1, Green discloses a composite core made of metal and plastic and a sheath enclosing the core (See Figures 6 and 7 and Column 5, lines 10-65). Green does not disclose the sheath being injection molded. Okumoto et al. discloses a composite core made of metal and plastic and an injection molded sheath enclosing the core (See Column 3, line 28, to Column 4, line 14). One having ordinary skill in the art would have found it obvious to injection mold the sheath, as taught by Okumoto et al., in order to ease manufacture.

Regarding claim 3, Green discloses the core having an injected molded plastic having metal particles dispersed therein.

Regarding claim 4, Green discloses the sheath having metal particles dispersed therein (See Column 4, lines 28-38).

Regarding claim 5, Green discloses the metal plastic forming the core being present in a ratio from about 90:10 to about 10:90 based on Figure 6.

Regarding claim 6, Green discloses the metal selected from steel.

Regarding claim 9, see the above regarding claims 1 and 3.

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Regarding claim 10, see the above regarding claim 5.

Regarding claim 11, see the above regarding claim 6.

Regarding claim 13, Green discloses the sheath made of a resilient plastic.

4. Regarding claim 14, Green discloses the club head being a putter head.

5. Claims 4, 15, 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okumoto et al. (USPN 5306450).

Regarding claim 4, Okumoto et al. does not disclose the sheath having metal particles. Applicant does not set forth any advantage, purpose, or problem being solved as why the sheath having metal particles is necessary to attain the claimed invention. One having ordinary skill in the art would have found such addition of materials to be an obvious design choice. The invention of Okumoto et al. would perform equally as well as that of the instant invention without the addition of metal particles within the sheath.

Regarding claim 15, Okumoto et al. does not explicitly disclose the thickness of the sheath. Applicant does not set forth why the claimed dimension of the sheath is result effective. One ordinarily skill in the art would have drawn from the Okumoto et al. that the size of the sheath is dependent on the size of the club head desired and the size of the mold. One having ordinary skill in the art would have found it obvious to have the sheath of any size so long as the final product is achieved.

Regarding claim 23, Okumoto et al. does not explicitly disclose the height of the front upper edge of the sheath. One having ordinary skill in the art is aware that the average golf ball has a mid point of 0.84 inches being that the golf ball has a diameter of 1.68 inches. The average golf ball is hit in an area around the midpoint of the golf ball.

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If the striking area is to be non-resilient, the club head would be dimension to reflect the above; therefore, placing the resilient portions over and under the above area would be obvious based on the dimensions of the average golf ball.

6. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebo et al. (USPN 3873094).

Regarding claim 27, Sebo et al. does not explicitly disclose the thickness of the sheath. Applicant does not set for the why the claimed dimension of the sheath is result effective. One ordinarily skill in the art would have drawn from the Sebo et al. that the size of the sheath is dependent on the size of the club head desired. One having ordinary skill in the art would have found it obvious to have the sheath of any size so long as the final product is achieved.

Regarding claim 28, Sebo et al. does not explicitly disclose the height of the front upper edge of the sheath. One having ordinary skill in the art is aware that the average golf ball has a mid point of 0.84 inches being that the golf ball has a diameter of 1.68 inches. The average golf ball is hit in an area around the midpoint of the golf ball. If the striking area is to be non-resilient, the club head would be dimension to reflect the above; therefore, placing the resilient portions out of the above area would be obvious based on the dimensions of the average golf ball.

Allowable Subject Matter

Claims 8 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAH

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